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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,025	12/29/2000	Jonathan W. Hubbs	29092.00011	7715

7590 02/21/2003

Squire, Sanders & Dempsey L.L.P.
Two Renaissance Square
Suite 2700
40 North Central Avenue
Phoenix, AZ 85004-4498

EXAMINER

BRUNSMAN, DAVID M

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 02/21/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/751,025

Applicant(s)

HUBBS, JONATHAN W.

Examiner

David M Brunsman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 and 41-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 and 41-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> . | 6) <input type="checkbox"/> Other: _____ |

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Applicant's response, including amendment, has been carefully considered but not found persuasive.

Claims 41-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 41-43 depend from a cancelled claim.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-38 and 41-46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The instant specification limits the invention to products that are firm, malleable enough to allow cleat penetration and easy repair, resistant to being pulled up in clumps, dust free and water resistant.

Claims 44-46 fail to recite the required presence of wax and clay. Page 4, lines 4-5 of the specification discloses that in order to perform these functions the invention must comprise a mixture of wax and clay, sand or decomposed granite being a preferred additional ingredient. Every embodiment enumerated at page 4, lines 12-16 requires wax.

The Background teaches that other combinations of soil or clay and an organic binder fail to perform the functions required of the invention such that a significant number of combinations that otherwise fall within the scope of the claims are inoperable. See, *In re Cook*, 169 USPQ 451

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and *In re Fisher*, 166 USPQ 18. The instant specification does not contain teaching how one of ordinary skill in the art could choose or predict which waxes are capable of making surface materials malleable and adding cohesiveness between particles. Simply reciting the desired result is not sufficient to adequately enable the claims. See, *In re Corkill*, 226 USPQ 1005.

Page 6, lines 11-13 of the specification require that the particular wax used must be capable of making the surface malleable and add cohesiveness, suggesting that some waxes would be inoperative. The only teaching allowing one of ordinary skill in the art to determine which waxes are operable is the selection of the two particular waxes described in the Tables of pages 5 and 6. Without evidence that one of ordinary skill in the art would expect most waxes to perform adequately or evidence the one would have been able to select operable waxes without undue experimentation the enabling scope of the disclosure is limited to waxes having properties similar to IGI 422 and IGI 1266U. Thus, in view of the evidence currently of record, claims 1-38 and 41-46 would fail to meet the enablement requirements of 35 U.S.C. 112, first paragraph. The examiner has established a reasonable basis, as set forth above, in pointing to specific compositions having the ingredients recited in the instant claims which are described by the instant specification itself as failing to perform the required functions.

Claims 37-38 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4925493.

The reference teaches a composition for surfacing horse racing tracks comprising soil made up of clay, silt, sand and organic matter and, wax. The sand recited is considered to anticipate decomposed granite. Because of the similar intended use, the composition would be expected to exhibit similar properties. Thus, reasoning for the examiner's assertion that similar

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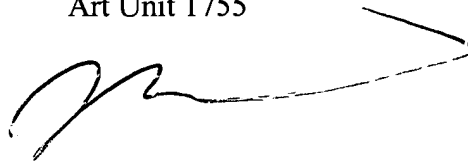
properties would be exhibited has been set forth. Applicant has submitted no rebuttal of that reasoning. Examiner agrees that page 1, lines 16-23 of the instant specification teach decomposed granite is a species of the soil including sand and silt.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M Brunsman whose telephone number is 703-308-3454. The examiner can normally be reached on M, W, F, Sa; 6:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 703-308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

David M Brunsman
Primary Examiner
Art Unit 1755



DMB
February 14, 2003